

## REMARKS

Claims 1, 4-10, 13-19 and 22-26 are pending. Claims 1, 10 and 19 are amended herein. No new matter is added as a result of the claim amendments. Support for the claim amendments can be found at least on page 10, lines 1-3 and 25-26.

### 112 Rejections

The instant Office Action states that Claims 1, 4-10, 13-19 and 22-26 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Independent Claims 1, 10 and 19 are amended herein to address this rejection. Applicants respectfully submit that Claims 1, 10 and 19, as amended, satisfy the requirements of 35 U.S.C. § 112, first paragraph, and that Claims 4-9, 13-18 and 22-26 also satisfy the requirements of 35 U.S.C. § 112, first paragraph, by virtue of their dependency on Claim 1, 10 or 19.

### 103 Rejections

The instant Office Action states that Claims 1, 4-10, 13-19 and 22-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over “The Transmeta Code Morphing™ Software: Using Speculation, Recovery, and Adaptive Retranslation to Address Real-Life Challenges” (hereinafter “Dehnert”) in view of U.S. Patent No. 5,881,280 to Gupta et al. (hereinafter “Gupta”). The Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 1, 4-10, 13-19 and 22-26 is not shown or suggested by Dehnert and Gupta, alone or in combination.

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP § 2142). In particular, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphases added) (MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment” (emphasis added) (MPEP § 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

For the reasons presented below, Applicants respectfully submit that Dehnert and Gupta cannot be combined in the manner suggested, because to do so would render one or the other of the references (specifically, Dehnert) inoperable for its intended purpose.

According to page 4 of the Office Action, Section 3.1 of Dehnert teaches exiting a first mode of speculative operation and entering a second mode of speculative operation. As understood by the Applicants, Dehnert teaches that speculation is permitted during a “translation;” if any exceptional condition occurs inside the translation, then a “rollback” is performed; and following the rollback, instructions are executed in the original program order. According to the Office Action, the period following the rollback is interpreted as the claimed second (partial) mode of speculative operation. However, Applicants respectfully submits that it would appear, because the instructions are executed in the

original program order, that Dehnert's second mode does not permit any speculation at all.

In other words, according to the present claimed invention, a full speculation mode and a partial speculation mode are enabled, and each of those modes permits a non-null set of speculative operations. But in Dehnert's "second mode" (that is, the period following a rollback), no speculative operations are permitted.

Applicants respectfully agree with the statements on pages 4 and 5 of the Office Action, to the effect that Dehnert does not teach partial speculative operation permitting speculation of a non-null set of speculative operations.

However, Applicants respectfully assert that Gupta cannot be combined with Dehnert in order to overcome this shortcoming. Even if Gupta does teach partial speculative operation permitting speculation of a non-null set of speculative operations, Gupta cannot be combined with Dehnert because that would impermissibly change a principle of operation of Dehnert. To reiterate, Dehnert's "second mode" does not permit speculation after rollback, but combining Gupta with Dehnert would impermissibly require Dehnert to permit speculation after rollback.

Because the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified (Dehnert), the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Therefore, Applicants respectfully submit that the basis for rejecting Claims 1, 4-10, 13-19 and 22-26 under 35 U.S.C. § 103(a) is traversed and that these claims are allowable over the cited references.

#### Conclusions

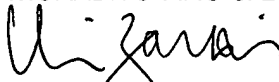
In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 1, 4-10, 13-19 and 22-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

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Respectfully submitted,  
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